

### REMARKS

In reply to the Final Office Action of December 31, 2008, the applicants submit the following remarks. Claims 1 to 25 are presently pending, with claims 15 to 24 having been withdrawn. Applicants have proposed to amend claims 1 and 12. Support for the amendments can be found at least in the specification as filed at page 5, lines 3-17. Applicants have also proposed to add new claim 26, which would be supported at least by FIG. 1 and on page 6, lines 19-26. Thus, the proposed amendments and new claim would add no new matter. This response is being filed concurrent with a request for continued examination under 37 CFR § 1.114. Applicants respectfully request entry of the proposed amendments and reconsideration in view of the amendments and the following remarks.

#### 35 U.S.C. Section 103

Claims 1-12 and 25 were rejected as being allegedly unpatentable over U.S. Patent No. 5,741,276 ("Poloyko") in view of U.S. Patent No. 5,254,130 ("Poncet") and in some cases, further in view of U.S. Patent No. 6,315,784 ("Djurovic"). Applicants respectfully disagree in light of the amendments made to claim 1 and the following remarks.

Amended claim 1 is directed to surgical suture placement device with a handle assembly, an elongated hollow outer tube connected at a proximal end to the handle assembly, a suturing assembly rotatably secured to a distal end of the elongated hollow outer tube, and a hollow inner tube located within the hollow outer tube and connecting the handle assembly to the suturing assembly by traversing the inside of the elongated hollow outer tube. The hollow inner tube, handle assembly and suturing assembly are non-rotatably connected to one another. The handle assembly is rotatable with respect to the hollow outer tube so that rotating the handle assembly while holding the outer tube stationary concurrently rotates the hollow inner tube and the suture assembly as a unit.

The most recent rejection points out that the handle assembly of Poloyko can be interpreted to include not only plunger 62, but also finger grip members 35 (see final Office Action at page 3). Thus, according to this interpretation, "rotating the handle assembly including

the plunger 62 and finger grip members 35 rotates the entire device, including the hollow inner tube and the suturing assembly, as a unit" (*id.*).

Applicants have proposed to amend claim 1 has been amended to further describe the relationship between the hollow inner tube, handle assembly and suturing assembly. Specifically, the hollow inner tube, handle assembly and suturing assembly are non-rotatably connected to one another, while the suturing assembly is rotatably secured to a distal end of the elongated hollow outer tube. Further, the handle assembly is rotatable with respect to the hollow outer tube so that rotating the handle assembly while holding the outer tube stationary concurrently rotates the hollow inner tube and the suturing assembly as a unit.

As noted by the Examiner, rotating the plunger 62 and finger grip members 35 of Poloyko rotates the entire device. It does not appear that any of the components of Poloyko's device are intended to rotate with respect to one another. Indeed, the rejection relies upon Poncet for a clevis 11 that is non-rotatably secured to a rotating member 7, where the rotating member 7 is rotatable with respect to a housing 3 (FIG. 1, col. 8, line 25-col. 9, line 8). The clevis 11 rotates when rotating member 7 is rotated (col. 9, lines 12-30).

The Examiner argues that it would have been obvious to one of ordinary skill in the art to modify the apparatus of Poloyko by providing the suture assembly (i.e., head 38) such that it is rotatably secured to the outer tube (36). However, amended claim 1 would require that the hollow inner tube, handle assembly and suturing assembly are non-rotatably connected to one another and the handle assembly is rotatable with respect to the hollow outer tube so that rotating the handle assembly while holding the outer tube stationary concurrently rotates the hollow inner tube and the suturing assembly as a unit. Poloyko's plunger 62 is not described as being rotatable with respect to the outer tube 36. Even if the plunger 62 were rotatable, rotating Poloyko's plunger 62 would cause tube 64, and the entire device, to rotate. Rotating the tube 64 without rotating handle 35 would torque flexible rod 54 and the flexibility of the rod 54 would cause the rod 54 to twist within head 38. Thus, handle 35 cannot be held stationary while the plunger 62 is separately rotated.

Stiffening rod 54 to ensure that rotating the rod 54 would cause the head 38 and tube 64 to rotate as a unit would disable Poloyko's device from operating in the way intended. That is, the plunger would no longer be able to push the needle out of the head 38 if the rod 54 were stiff

and could not bend in the curved needle cavity. Such a modification cannot be made to Poloyko's device, because the proposed modification cannot change the principle of operation of the device (MPEP 2143.01 VI).

Djurovic was relied upon to show an alternative to feed suturing material to the needle and does not teach the features lacking from the combination of Poloyko and Poncet and required by amended claim 1.

In light of the amendment made to claim 1, applicant submits that there is no *prima facie* case of obviousness. Claims 2-12, 25 and new claim 26 depend from claim 1, and thus there is no *prima facie* case of obviousness made for these claims for at least the same reasons. Therefore, applicants respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103.

#### Rejoinder

Upon allowance of any of the device claims, applicants respectfully request that any withdrawn method claims that require all of the limitations of the allowed device claim be considered for rejoinder under MPEP 821.04(b).

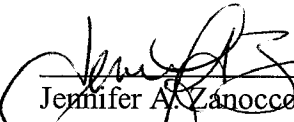
CONCLUSION

Applicants respectfully request that all claims be allowed. Applicants do not concede any positions of the Examiner that are not discussed above, nor do applicants concede that there are not other good reasons for patentability of the presented claims or other claims. The extension fee for one month in the amount of \$65 and an excess claim fee in the amount of \$26 are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 7917-0160001.

Respectfully submitted,

Date: \_\_\_\_\_

*April 30, 2009*

  
\_\_\_\_\_  
Jennifer A. Zano  
Reg. No. 54,563

Customer No. 26161  
Fish & Richardson P.C.  
Telephone: (650) 839-5070  
Facsimile: (877) 769-7945